

REMARKS

Claims 1 and 3-5 are pending in this application, of which claims 1 and 5 have been amended. Claim 2 has been canceled. No new claims have been added.

The Examiner has maintained from the previous Office Action the 35 U.S.C. § 102(b) rejection of claims 1 and 5 as anticipated by **Fujioka et al.** and the 35 U.S.C. § 103(a) rejection of claims 3 and 4 as unpatentable over **Fujioka et al.** in view of **Shepherd**.

Applicants respectfully traverse this rejection.

As noted in Applicants' previous response filed June 15, 2005, the final product disclosed in **Fujioka et al.** is an electrostatic record material comprising a paper substrate, an electroconductive layer and a record forming layer. The portion of **Fujioka et al.** quoted by the Examiner (column 5, lines 33-44) relates not to the final product but to an intermediate product which is composed of a paper substrate and an electroconductive layer. Such an intermediate product per se cannot be used as a recording material. In fact, **Fujioka et al.** does not disclose or suggest use of the intermediate product per se or any advantages of the intermediate product.

In the outstanding Office Action, the Examiner has urged that:

Because the material is used to make the invention, the cationic resins, such as quaternary ammonium salts, surface resistivity of 10^6 to $10^{10} \Omega$ and 2 to 20 g/m² by weight are present in the final product of the invention.

Accordingly, the presently claimed paper should be compared not with the intermediate product, but with the final product disclosed in **Fujioka et al.**

As recited in claim 1, as amended, of the instant application, the cationic resin is present on a side of the support on which ink jet recording or electrophotographic recording is to be effected, and the surface resistivity of the recording side of the paper is $1.0 \times 10^9 - 9.9 \times 10^{13} \Omega$.

In contrast, the final product disclosed in **Fujioka et al.** comprises a paper substrate, an electroconductive layer and a record forming layer, where the record forming layer is composed mainly of an insulative resin.

Therefore, in **Fujioka et al.**, a cationic resin is not present on the recording side, and **Fujioka et al.** does not teach, mention or suggest that the surface resistivity of the recording side of the paper is $1.0 \times 10^9 - 9.9 \times 10^{13} \Omega$. In **Fujioka et al.**, there is nothing to lead one of ordinary skill in the art to the present invention.

Moreover, the Examiner alleges that in instant claim 1, the phrase “as measured by colloidal titration method” introduces a process limitation to the product claim, and hence claim 1 is a product-by-process claim (paragraph bridging pages 2 and 3 of the Office Action). However, this phrase specifies the cation equivalent of the cationic resin which is one of the components of the recording paper of the present invention. Thus, the phrase does not relate to a process for producing a recording paper, as incorrectly alleged by the Examiner.

As argued in our response of March 14, 2003:

Applicants note that the limitation as to the testing method in Claim 1 is not a production process but a method of measuring the cation equivalent. Applicants are not implying or even suggesting that the test method is novel. Rather, the claim requires only that the cation equivalent of the resin is 3-8 meq/g when tested by a particular method. The fact that a reference teaches about this method is immaterial to the present claim, absent a suggestion to use a coating that shows

the claimed range of cation equivalent, and there is no suggestion in Noguchi et al. or Fujioka et al. to use a resin that shows a cation equivalent that is 3-8 meq/g when tested by the colloidal titration method. There is only a suggestion to measure a cation equivalent of a selected resin by the colloidal titration method.

Shepherd has been cited for teaching paper sizing materials consisting of rosin (column 1, lines 18-20) and alkenyl succinic anhydride sizing agents (column 2, lines 45-63).

Shepherd, like Fujioka et al. discussed above, fails to teach, mention or suggest the limitations recited in claim 1, as amended, from which claims 3 and 4 depend.

Thus, the 35 U.S.C. § 102(b) and 35 U.S.C. § 103(a) rejections should be withdrawn.

In view of the aforementioned amendments and accompanying remarks, claims 1 and 3-5, as amended, are in condition for allowance, which action, at an early date, is requested.

If, for any reason, it is felt that this application is not now in condition for allowance, the Examiner is requested to contact Applicants' undersigned attorney at the telephone number indicated below to arrange for an interview to expedite the disposition of this case.

In the event that this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. Please charge any fees for such an extension of time and any other fees which may be due with respect to this paper, to Deposit Account No. 01-2340.

U.S. Patent Application Serial No. **09/508,617**
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Respectfully submitted,

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